

REMARKS

By this Amendment, Applicant amends claim 1 and cancels claims 3 and 6-9, without any prejudice or disclaimer to the subject matter thereof. Applicant also adds new claim 10 to address another aspect of the present invention. Claims 1, 2, 4, 5, and 10 are currently pending.

In the Office Action, the Examiner objected to the title of the specification as being not descriptive; and rejected claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0017846 to Estevez et al. ("Estevez") in view of U.S. Patent Application Publication No. 2005/0038660 to Black et al. ("Black").¹

Regarding the objection

Applicant respectfully traverses the Examiner's objection to the title of the specification. However, to expedite the prosecution of this application, Applicant has amended the title to be more clearly indicative of the invention. Accordingly, Applicant respectfully requests withdrawal of the objection to the title of the specification.

Regarding the claim rejection under 35 U.S.C. § 103

Applicant respectfully traverses the Examiner's rejection of claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Estevez in view of Black, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference (or references when

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Independent claim 1, as amended, recites a combination including, for example, “the means for inputting audio information includes means for switching the inputted audio information between the instruction information subjected to the recognition processing and the audio message used by the external device.” Estevez fails to teach or suggest at least the above element as recited in amended claim 1, as conceded by the Examiner in stating “Estevez does not specifically disclose means for inputting audio information” (Office Action at 3.). Further, Black fails to cure Estevez’s deficiencies.

The Examiner alleges that “Black et al. discloses the means for inputting audio information comprises means for discriminating the inputted audio information into audio information subjected to recognition processing by the means for performing recognition processing and an audio message used by the external device (See Black sections [0009]-[0014], [0024], [0025], [0027]-[0029], and [0033]-[0040]).” (Office Action at 7.) Applicant respectfully disagrees.

Although Black, in the sections listed by the Examiner, teaches that “[t]he audio input device 11 enables the presenter to input voice commands and oral presentation information to the media device 7 via the media control device 60 and communication channel 132,” para. [0038], Black fails to teach “switching the inputted audio information

between the instruction information subjected to the recognition processing and the audio message used by the external device,” as recited in amended claim 1 (emphasis added). In fact, Black sends both the voice commands and the oral presentation information to media device 7 by explicitly stating that “the parallel void/audio data is sent to the audio port 606 fro reproduction by the audio system 8 of media device.” Black, para. [0048], emphasis added. That is, Black does not switch the voice command and the oral presentation information, both of which are sent to media device 7 and reproduced as audio. Therefore, Black’s teaching for reproducing both the voice command and the oral presentation information does not constitute “switching the inputted audio information between the instruction information subjected to the recognition processing and the audio message used by the external device,” as recited in amended claim 1 (emphasis added).

Therefore, neither Estevez nor Black, taken alone or in any reasonable combination, disclose all elements of Applicant’s invention as recited in amended claim 1. A *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 1. Because claims 2, 4, and 5 depend from claim 1, Applicant also requests withdrawal of the Section 103(a) rejection of claims 2, 4, and 5 for at least the same reasons stated above. Further, because claims 3 and 6-9 have been canceled, the Section 103(a) rejection of claims 3 and 6-9 is moot.

Regarding the newly added claim

Applicant has added claim 10 to address another aspect of the present invention. Support for claim 10 may be found at, for example, pages 16 and 17 and FIG. 4 of the

specification. Because claim 10 depends on claim 1, claim 10 is also allowable for at least as being dependent from an allowable base claim.

In addition, Applicant respectfully submits that the Examiner's applied references fail to teach or suggest at least "the instruction information subjected to the recognition processing controls an operation of the external device without being reproduced by the external device as audio; and the audio message transmitted to the external device is reproduced by the external device as audio," as recited in claim 10 (emphasis added).

Conclusion

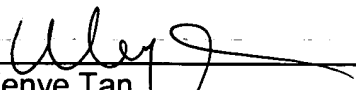
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 30, 2006

By: 
Wenye Tan
Reg. No. 55,662